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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 928.810	08 13 2001	James J. Lalonde	1690A1	8220

7590

08 18 2003

PPG INDUSTRIES, INC.
Intellectual Property Department
One PPG Place
Pittsburgh, PA 15272

EXAMINER

MARX, IRENE

ART UNIT PAPER NUMBER

1651

DATE MAILED: 08 18 2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/928,810

Applicant(s)

LALONDE, JAMES J.

Examiner

Irene Marx

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 19 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 16-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 31-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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The amendment filed 6/19/03 is acknowledged. Claims 1-15 and 31-40 are being considered on the merits.

In keeping with scientific custom, the names of genera and species of microorganisms should be underlined or italicized throughout the specification and claims.

Claims 10 and 35 are inconsistent in the recitation of "about 250 g/L" about 250 mM glutamine, respectively. Which is correct? The specification suggests it is "g/L". Also, to clarify the invention, and for proper antecedent basis it is recommended that claims 10 and 35 be amended to recite a range of "about 25 mM to about 250 ... glutamine".

Applicant's continued traversal of the restriction requirement with respect to Groups I and II is acknowledged. Applicants now argue that the bacteria and starting material of L-glutamine would produce 2-oxoglutaramate and no other product "as claimed". However, these arguments are directed to the intended use of the reaction mixture. That strains of *Providencia* or *Proteus* have "the capacity to convert L-glutamine to 2-oxoglutaramate" does not mean that the bacteria will necessarily and exclusively carry out the bioconversion to 2-oxoglutaramate in preference to or in exclusion of other metabolic functions for the production of other metabolic products such as enzymes or biomass.

Regarding the search burden, for purposes of the initial restriction requirement a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant. Insofar as the criteria for restriction practice relating to Markush-type claims is concerned, the criteria is set forth in MPEP 803.02. Insofar as the criteria for restriction or election practice relating to claims to genus-species, see MPEP 806.04(a) - 806.04(j) and MPEP 808.01(a).

In addition, classification of subject matter is merely one indication of the burdensome nature of the search involved. The literature search, particularly relevant in this art, is not co-extensive and is much more important in evaluating the burden of

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search. Burden in examining materially different groups having materially different issues also exists.

Claims 16-30 remain withdrawn from consideration as directed to a non-elected invention.

The rejection under 35 U.S.C. § 112, first paragraph with respect to deposit is withdrawn in view of the Pingitore declaration.

Claims 5-8, and 14-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 is vague, indefinite and confusing in that the correlation between "for a time sufficient to produce..." in claim 1 and the recitation "a time period either in two or more aliquots or as a steady trickle" is uncertain.

In claim 6 it is unclear at what point the incubation is stopped. Is it after the product is produced or before?

Claims 7 and 8 fails to find clear antecedent basis in claim 1 for "the oxoglutaramate product". Claim 1 recites "a product comprising oxoglutaramate".

In claim 14, "said solution slurry" should be amended to "said incubation solution slurry" for proper antecedent basis.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3, 5-11, 13-15, 31, 33-40 are/remain rejected under 35 U.S.C. 103(a) as being unpatentable over Meister taken with Szwajcer *et al.* for the reasons as stated in the last Office action and the further reasons below.

Response to Arguments

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Applicant's arguments have been fully considered but they are not deemed to be persuasive.

Applicants arguments regarding the unpredictability of the effects of the oxidative deamination of glutamine using the enzymes of specific bacterial cells as disclosed in Szwajcer *et al.* are persuasive. However, these arguments are not directed to the effects of using unknown strains of *Providencia* or *Proteus* or "active" enzymes thereof in the process.

Therefore the rejection is deemed proper and it is adhered to.

Claims 4, 12, 17, 19, 28, 29 and 32 would be allowable upon resolution of all 35 U.S.C § 112 issues. Applicants' arguments regarding the unpredictability of the claimed bioconversion using the specifically recited strains *per se* are persuasive. There would have been no motivation for one of ordinary skill in the art to modify the disclosure of the cited references by submitting L-glutamine to a process of bioconversion with these specific strains to produce 2-oxoglutaramate at the time the claimed invention was made..

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

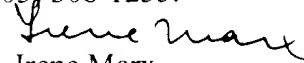
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is (703) 308-2922. The examiner can normally be reached on Monday through Friday from 6:30 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (703) 308-4743. The appropriate fax

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phone number for the organization where this application or proceeding is assigned is before final (703) 872-9306 and after final, (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Customer Service whose telephone number is (703) 308-0198 or the receptionist whose telephone number is (703) 308-1235.


Irene Marx
Primary Examiner
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